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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 10/675,703 | 09/30/2003 | Philip R. Kennedy | 18657.1 | 6330 |
| 25854 | 7590 | 12/14/2005 | EXAMINER | |
| BRYAN W. BOCKHOP, ESQ. 2375 MOSSY BRANCH DR. SNELLVILLE, GA 30078 | | | NASSER, ROBERT L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3736 | |
| DATE MAILED: 12/14/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|-------------------------------------------|--|
| Office Action Summary | Application No. 10/675,703 | Applicant(s) KENNEDY, PHILIP R. | |
| | Examiner Robert L. Nasser | Art Unit 3736 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pless et al 6597954 in view of Cosgrove Jr. et al 4533346. Pless et al shows a system including a plurality of electrodes implanted under the skin and a transponder 110 that is also capable of being implanted between the cranium and scalp, where the transponder measures the potential difference between a pair of the implanted electrodes and wirelessly transmits the difference to an external receiver. It does not have conductive screws for the electrodes. However, Cosgrove teaches that stainless steel conductive screws are well known electrodes for sensing potentials in the brain (see column 11, line 44). Hence, it would have been obvious to modify Pless et al to use screw electrodes, as it is merely the substitution of one known equivalent electrode for another. The examiner notes that the screws are not intended to be placed through the skull. However, the term "skull screw" is an intended use limitation, i.e. it goes to how the screw is used. The screws of Cosgrove are structurally similar to applicant's and hence capable of being used as skull screws. The claims now recite that the screws have a length that corresponds to the cranium but less than a length that would cause the screws to invade the cranium. In paragraph [0021], applicant defines this length as being ¼ to 1.5 inches. The screws of Cosgrove are ½ of an inch and hence fall into the claimed range. In addition, applicant now recites that the screws now have

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a "substantially" constant outer diameter. It is the examiner's position that the flat head screws in applicant's exhibit or other flat head screws have a "substantially" constant diameter, given that applicant has not defined the term "substantially."

With respect to claims 6 and 7, Pless et al teaches the method, including an amplifier 712 for amplifying the potential difference prior to transmitting.

Claims 2 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pless et al in view of Cosgrove Jr. et al as applied to claim 1, 3, 6, and 7 above, further in view of Fischell et al 6647296. Pless has all of the features of claims 2 and 8, except for the induction circuit to supply power to the device. Fischell teaches such an induction power circuit to allow powering the device from the outside of the patient. As such, it would have been obvious to modify the above combination to use such an induction circuit, as it is merely the substitution of one known power supply method for another.

Applicant's arguments filed 9/30/2003 have been fully considered but they are not persuasive.

Applicant has asserted that the screws of Cosgrove invade the brain while applicants do not. The examiner notes that this is an intended use limitation and not sufficient to overcome the rejection, since the screws of the reference meet the structural features of the claims. See *In re Schreiber* 44 USPQ 2d 1429 (Fed. Cir. 1997).

Applicant has asserted that a flat head screw is different than a "skull screw." The examiner notes that the screws of Cosgrove (1/2 inch long flat head screws) meet the claim features as discussed above. The term "skull" screw merely means a screw capable of being placed in the skull.

Applicant has also asserted that the claims recite that the screws have a substantially constant outside diameter. While this is shown in the drawings, it is absent from the specification. As such, there is no definition of what "substantially" constant means and it is the examiner's position that a flat head screw has a diameter that , while it is not constant, is "substantially constant" outside diameter. The length limitation is addressed above.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser whose telephone number is (571) 272-4731. The examiner can normally be reached on Mon-Fri, variable hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Robert L. Nasser
Primary Examiner
Art Unit 3736

RLN
December 8, 2005



ROBERT L. NASSER
PRIMARY EXAMINER